

REMARKS

This paper is in response to the Office action mailed April 14, 2011. It is believed that no fees are due in connection with the present Amendment. However, in the event any fees are due, kindly charge the cost thereof to our Deposit Account No. 13-2855.

Status of the Claims

Claims 21-54, 56 and 58 are pending in the present application, with claims 21-24 and 40-52 withdrawn from consideration. No amendments to the claims are made at this time. The Examiner's attention is directed to the amendment after final submitted January 24, 2011 for a listing of the claims as presently pending in the application.

Response to Rejections Under 35 USC § 102

Claims 25, 27, 29, 31, 32, 36, 53, 54, 56, and 57 were rejected under 35 USC § 102 as allegedly anticipated by Kobayashi et al., US Patent No. 4,974,238 ("Kobayashi"). Each of independent claims 25, 36, 56, and 57 includes the feature (albeit worded slightly differently in certain of the claims): "... wherein the invalid indication includes an internal control signal which disables the printing apparatus, such that printing operations cannot be implemented for a consumable having an identifier in said list." In other words, once a consumable is identified as being a used consumable, that consumable can no longer be used in the printing apparatus.

The April 14, 2011 Office action indicates that this feature is shown in lines 4 to 11 of column 6 of Kobayashi where it is stated "...the process proceeds to the block 108 where the operator is notified on the operator panel that maintenance is required. In the embodiment being described, however, a drum having a used life count exceeding the predetermined life can be continued to be used if so desired by the operator. To this end, a switch can reset the warning or the alarm (not shown)". The Office action sets out from the second paragraph of

page 3 to the end of the first paragraph of page 4 of the description reasons why it is considered that this portion of Kobayashi discloses the disabling of printing.

In particular, the Office action states “note disabling is achieved by displaying an error message (Col. 4 line 47) to a user and until that message is reset by a user (Col 6 lines 7-9), the operations of the printer are remained disabled [sic.]”. As discussed in Applicants’ previous response, it is respectfully submitted that it is speculative that the printer of Kobayashi is disabled until the alarm is reset, as the reference does not expressly disclose this feature. The Applicants submit that nowhere in the Kobayashi reference does it disclose that printing is disabled.

An alternative interpretation of Kobayashi to that taken in the Office action is that the operator is notified by the alarm that maintenance is required, but that the operator can still print using the consumable (“a drum having a used life count exceeding the predetermined life can be continued to be used if so desired by the operator”), and that the user can optionally reset the alarm if they so wish (since the user has been made aware that maintenance is required there is no need for the alarm to remain on). An analogy to this interpretation of Kobayashi could be considered a low fuel warning light in a vehicle, in which the warning light is illuminated to indicate to a driver that they have nearly run out of fuel. The illumination of the fuel warning light does not disable the vehicle.

Inasmuch as Kobayashi does not expressly disclose the features “...wherein the invalid indication includes an internal control signal which disables the printing apparatus, such that printing operations cannot be implemented for a consumable having an identifier in said list”, it is respectfully submitted that Kobayashi does not anticipate any of independent claims 25, 36, 56, and 57, or any claims depending therefrom. Withdrawal of the anticipation rejections under Kobayashi is respectfully requested.

Response to Rejections Under 35 USC § 103

Claims 26, 28, 30 ,33-35, 37-39, 55, and 58 were rejected under 35 USC § 103 as allegedly obvious to one of ordinary skill in the art at the time of the invention from Kobayashi in view of Klinefelter et al., WO 2000/43932 (“Klinefelter”). Inasmuch as Kobayashi discloses allowing a user to continue using a consumable even when its useful life count is considered to have expired, it is respectfully submitted that the Kobayashi reference expressly teaches away from the Applicants’ claims 26, 28, 30 ,33-35, 37-39, 55, and 58. These claims are directed at preventing such continued use, as reflected in the claim language reciting “... wherein the invalid indication includes an internal control signal which disables the printing apparatus, such that printing operations cannot be implemented for a consumable having an identifier in said list” (or language to that effect). As such, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine or modify Kobayashi with Klinefelter in the manner proposed in the Office action. Withdrawal of the rejections under 35 USC § 103 is therefore respectfully requested.

Conclusion

In view of the above remarks, Applicants submit the pending application is in condition for allowance. The Examiner’s reconsideration and favorable action are solicited.

Dated: July 14, 2011

Respectfully submitted,

By /Jeremy R. Kriegel, Reg. No. 39,257/

Jeremy R. Kriegel

Registration No.: 39,257

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive

6300 Willis Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicants